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| 09/592,284 | 06/12/2000 | FRANCOIS SMOLAREK | 106498 | 5209 |

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| EXAMINER |
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HECKENBERG JR, DONALD H

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| ART UNIT | PAPER NUMBER |
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1722

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,284

Applicant(s)

SMOLAREK, FRANCOIS

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 87,89-98,116 and 117 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 80,81,101 and 115 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1,3-11,13-22,24-33,35-44,46-55,57-64,66-76,78-87,89-119 and 129-131.

Continuation of Disposition of Claims: Claims rejected are 1,3-11,13-22,24-33,35-44,46-55,57-64,66-76,78,79,82-86,99,100,102-114,118,119 and 129-131.

1. Claims 87, 89-98, 116, and 117 are drawn to a method for manufacturing a stick which is distinct from the other claims, which are drawn to a mold (see previous Office Actions).

In the response of 03 January 2005, Applicant's argue that the method claims include all of the limitations of the elected product claim, and thus should be rejoined upon allowance of claim 1.

Claim 1 and claim 87 are not related as product and process- the claimed mold is not a product of the claimed process. Rather, as set forth in the previous Office Actions, claim 1 and claim 87 are related as process and apparatus for its practice.

Moreover, the mold defined within the process recited in claim 87 does not have all the limitations recited in claim 1 of the instant application. For example, the mold in claim 1 is recited with "the side wall being deprived of recesses opening out into the internal surface[.]" This feature is not recited in claim 87.

Still further, as set forth below, claim 1 is not considered allowable at this point.

For all of these reasons, rejoinder of claims 87, 89-98, 116 and 117 is not appropriate. Claims 87, 89-98, 116 and 117

are therefore withdrawn from further consideration as being directed to a non-elected invention.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-6, 10, 33, 35-38, 43, 44, 46-49, 54, 69, 72, 73, 75, 78, 79, 85, 86, 99, 100, 102, 103, 110, 111, 113, 114, 118, and 129-131 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (U.S. Pat. No. 3,934,810; previously of record).

Henning discloses a flexible mold. In the embodiments shown in Figures 1, 3, 7, and 8, the mold comprises a side wall having an external surface and an internal surface configured to be in contact with the product. The side wall is deprived of recesses opening out into the internal surface of the mold (see for example, Figs. 3 and 8). The side wall is provided with recesses in the form of notches (27 and 87) facilitating the radial deformation of the mold (cl. 1, ll. 59-66). The notches have longitudinal edges having a length on the external surface

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(see Fig. 7). A portion of the edge adjacent to a periphery of the mold is spaced apart over at least part of the length prior to any deformation of the mold (see cl. 3, ll. 52-54 noting the recesses portion to be a channel, and Figs. 3 & 7 showing the channel extending to the external surface of the mold, thereby constituting an edge portion of the recess not touch over a portion of the recess length prior to deformation of the mold). As shown in the embodiment depicted in Fig. 1, the channel includes a portion at the bottom of the recess, and thus spaced from an upper end of the recess.

Henning further discloses the notches to extend substantially over an entire height of the mold all the way to a bottom end of the mold beyond a bottom of the inner cavity (81) of the mold, and the notches being uniformly distributed in the periphery of the mold (see Figs. 7-8). As noted above, a bottom of the notch is rounded (cl. 3, ll. 52-54). Henning also discloses the mold to be provided with a flange (77) at the top portion surrounding an opening of the mold (see fig. 7). In an the embodiment shown in Figs. 1 and 5, Henning discloses that the depth of the notches may decrease on coming towards a bottom end of the mold (see cl. 4, ll. 13-29).

Claims 69, 72, 73, and 114 recite that the mold is configured to be filled with a cosmetic product. The actual use

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of the apparatus, whether it be to make a cosmetic product or anything else, is not germane to the issue of patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); MPEP § 2115. In the instant case, Henning discloses a mold to be used with "a hardenable mixture" (col. 1, l. 6), and to comprise a completely closed cavity (81) for containing the mixture (see fig. 7). Therefore, the apparatus of Henning is capable of being used with a hardenable mixture such as that which would form a cosmetic product, and therefore anticipates the limitations of claims 69, 72-73, 86, and 114.

Claim 118 recites that the mold is made of a material that is physically and chemically compatible with polydimethyl siloxane silicon at a temperature of about 100°C. Although Henning does not disclose the use of the apparatus for molding polydimethyl siloxane silicon, this actual use of this material is a limitation is directed towards the intended use of the apparatus, which is not germane to the issue of patentability as discussed above. Henning does disclose that the apparatus is capable of molding hardenable materials. (see for example, col.

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1, 11. 3-6). Given the disclosed structure, the mold of Henning would inherently have to be made of a material physically and chemically compatible with polydimethyl siloxane silicon.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 7-10, 39-42, 50-53, 82-84 and 104-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning.

Henning discloses the mold as described above. Henning does not disclose the mold to have 16 to 20 notches, or more specifically 18 notches. Henning does, however, disclose that the number of notches is not critical, and that more or less can be included (see cl. 4, ll. 30-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the mold disclosed by Henning as such to have provided 18 notches because the number of notches is not critical and can be adapted to meet the particular use of the apparatus as suggested by Henning.

Claims 7, 39, 50, 84 and 104 recite that the maximum depth of the notches is greater than or equal to 4 mm. Claims 9, 42, 53 and 106 recite that the thickness of the side wall in the recess is greater than or equal to 4 mm. Henning notes that the size of the notches and wall must be as such that the integrity of the shaping cavity remains intact (cl. 4, ll. 44-52). Henning thus discloses that the size of the notches and wall are cause-effective variables that determine the integrity of the mold based for particular molding conditions. The determination of optimum values of cause effective variables are generally seen as within the skill of one practicing the art absent a showing of an unexpected result. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Aller, 220 F.2d 454, 105 USPQ 233

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(CCPA 1955). In the instant case, given Henning disclosure of the relation of mold integrity to the size of the notches and wall, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have varited the sizes used for the notches and wall to include such dimensions as 4 mm or greater for the notches and 1 mm or greater for the side wall in the recesses because this would allow for the optimum integrity of the mold based on these cause effective variables

7. Claims 11, 13-22, 24-32, 55, 57-64, 66-68, 70, 71, 74, 76, 108, 109 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning as applied to claims 1, 3-10, 33, 35-44, 46-54, 69, 72, 73, 75, 78, 79, 82-86, 99, 100, 102-107, 110, 111, 113, 114 and 118 above, and in view of Fox et al. (U.S. Pat. No. 3,937,438; previously of record).

Henning discloses and suggests the apparatus as described above. Henning does not disclose the mold cavity opening to have a sloping bottom wall, or a mold cavity having a part formed by two successive conical surface converging towards an opening in the mold, or the mold cavity to be partially defined by a conical surface.

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The mold cavity and mold cavity opening shapes determine the shape of the product to be manufactured. Henning discloses different cavity shapes which form products of different shapes (compare cavity 25 in the embodiment shown in Figures 2-4, with the cavity 81 shown in Figures 7 and 8). In the same field of endeavor, Fox discloses another example of a different cavity shape (21) to produce different shaped products (45). Therefore, it is known in the art that the shape of the mold cavity and mold cavity opening may be manipulated in order to produce products of different shapes.

Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the mold cavity and mold cavity opening of Henning as such to have a sloping bottom wall, two successive converging conical surfaces, or be partially defined by a conical surface because these shapes would have allowed for the molding of correspondingly shaped products as is suggested by Henning and Fox.

8. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henning in view of Llorente Hompanera (U.S. Pat. No. 6,197,359; previously of record).

Henning discloses a molding apparatus as described above. Henning notes that the mold is made of flexible elastomeric materials (cl. 2, ll. 43-47), but does not specify the exact material.

Llorente Hompanera discloses that fluoro silicone rubber materials are known for making flexible elastomeric molds (cl. 1, ll. 38-46 and ll. 63 and 64).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used a fluoro silicone rubber for construction of the mold of Henning because such a material is known for its flexible elastomeric properties as suggested by Llorente Hompanera.

9. Applicant's arguments filed 03 January 2005 have been fully considered but they are not persuasive.

Applicant, referencing the embodiment shown in Figure 7 of Henning, argues that Henning does not teach or suggest edges having portions that are spaced over a length of the recess prior to a deformation of the mold and spaced from an upper end of the recess as set forth in claims 1, 33, 44, 75 and 99.

Applicant's argument does not consider the other embodiments disclosed by Henning. For example, Figure 1 shows the slit 27 as having a channel 33 at the top and bottom of slit

36. The bottom portion of this channel 33 represents a portion spaced apart over part of the length of the slit and spaced from an upper end of the recess as required by the claims of the instant application.

10. Claims 80, 81, 101 and 115 are allowed. See the reasons for indicating allowable subject matter in the previous Office Action.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Donald Heckenberg", with a stylized flourish extending to the right.

4-18-5

Donald Heckenberg
Patent Examiner
A.U. 1722